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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/971, 172 11/14/97 GOODMAN

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HM12/0121

EXAMINER

RICHARD ARON OSMAN
SCIENCE AND TECHNOLOGY LAW GROUP
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HILLSBOROUGH CA 94010

TURNER, S

ART UNIT	PAPER NUMBER
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1644

18

DATE MAILED:

01/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/971,172	Applicant(s) Goodman
	Examiner Sharon L. Turner, Ph.D.	Group Art Unit 1644

Responsive to communication(s) filed on 11-15-99

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- Claim(s) 10-67 is/are pending in the application.
 Of the above, claim(s) 43-49 is/are withdrawn from consideration.
- Claim(s) _____ is/are allowed.
- Claim(s) 10-42 and 50-67 is/are rejected.
- Claim(s) _____ is/are objected to.
- Claims _____ are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on _____ is/are objected to by the Examiner.
- The proposed drawing correction, filed on _____ is approved disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All Some* None of the CERTIFIED copies of the priority documents have been
- received.
 - received in Application No. (Series Code/Serial Number) _____.
 - received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- Notice of References Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). 9
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

Art Unit: 1644

Response to Amendment

1. The Examiner of U.S. Patent application SN 08/971,172 has changed. In order to expedite the correlation of papers with the application please direct all future correspondence to Examiner Turner, Technology Center 1600, Art Unit 1644.
2. The amendment filed 11/17/99 has been entered into the record and has been fully considered. Claims 10-67 are pending. Claims 10-42 and 50-67 are under examination.
3. In view of applicants amendment, all rejections not reiterated herein have been withdrawn by the examiner.
4. This application contains claims drawn to an invention nonelected without traverse in Paper No. 5. Acknowledgement is made of applicants request for rejoinder of method claims 43-49 upon allowability, however the request is not granted because the claims are not in form for allowance in light of the new rejections set forth herein.
5. Claims 43-49 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as set forth in the final office action mailed 10-14-99, Paper No. 13, as being drawn to a non-elected invention, the requirement having been traversed in Paper No. 5.

New Rejections

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any

Art Unit: 1644

person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 10-42 and 50-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “flanking” is indefinite because the skilled artisan is not clearly apprised of the metes and bounds of the claim. Flanking sequences could refer to sequences on either side or alternatively sequences on both sides. Further is the 500 base pair limitation meant to be extended on both sides (i.e., the full length up to 500bp + 36bp (subsequence) +500bp = a 1036bp molecule) or a total of 500 base pairs flanking both sides (i.e., a 536 bp molecule). Is a sequence which has 0 flanking sequences to one side but flanking sequences to the other side flanked?

The term “native” is indefinite because the skilled artisan is not clearly apprised of the metes and bounds of the claim. Which sequences are inclusive of native sequences and which are excluded?

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1644

9. Claims 10-11, 19-20, 28-29, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilson et al, *Nature*, 368(6466):32-38, 1994 as evidenced Sambrook et al, *Molecular Cloning*, Cold Spring Harbor Labs, 1989, p.4.7-4.9 and 4.12-4.13. This reference was previously cited in the office action of 3-5-99, Paper No. 8.

Wilson et al teach the recombinant nucleic acid molecules, and the cells comprising the recombinant nucleic acid molecules as recited in claims 10-11 and 19-20. In particular, the nucleic acid sequence encodes an amino sequence which shares identity with the amino acid sequence of SEQ ID NO:6, see especially alignments with SEQ ID NO:6, SPTREMBL Accession No. O01632, which is flanked by fewer than 500 bp of native flanking sequence, in particular 12 consecutive residues of SEQ ID NO:6, within less than 500 bp of the ends of the molecule. Wilson et al teaches cloned sequences using M13 subclones, see p. 32, Sequencing strategy and Sambrook et al, p. 4.7-4.9 and 4.12-4.13, in particular. Thus, there are 2 interpretations the first being that the end sequences of this accession are not “flanked” and the second being that they are flanked by non “native” sequences (M13 phagemid). The recombinant nucleic acid molecule comprises at least one of residues 1-12 of SEQ ID NO:10 as claimed in claim 28, see threonine residue 874 of reference and threonine residue 1297 of SEQ ID NO:6, instant application, in particular. Thus, the reference teachings anticipate the claimed invention.

Status of Claims

Conclusion

Art Unit: 1644

10. No claims are allowed.

11. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon L. Turner, Ph.D. whose telephone number is (703) 308-0056. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached at (703) 308-3973.

Sharon L. Turner, Ph.D.

January 18, 2000

Christina Chan
CHRISTINA Y. CHAN
SUPERVISORY PATENT EXAMINER
GROUP 1600